

REMARKS

Applicant submits this Amendment in reply to the Office Action mailed June 16, 2006.

By this Amendment, Applicant cancels claims 14 and 74, without prejudice or disclaimer, amends claims 1, 15, 16, 19, 22, 39, 61, 75, 76, 79, 86, and 103, and adds new claims 120-135. The originally-filed specification, drawings, and claims fully support the subject matter of amended claims 1, 15, 16, 19, 22, 39, 61, 75, 76, 79, 86, and 103, and new claims 120-135. No new matter has been introduced.

Before entry of this Amendment After Final, claims 1-39, 61-107, 109, 112, 115, and 118 were pending in this application. After entry of this Amendment After Final, claims 1-13, 15-39, 61-73, 75-107, 109, 112, 115, 118, and 120-135 are pending in this application. Claims 1, 22, 61, and 86 are independent claims.

On pages 2-3 of the Office Action, claims 1-4, 7-10, 14-26, 30-34, 38, 39, 61-64, 67-70, 74-90, 94-98, 102-107, 109, 112, 115, and 118 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto. Applicant respectfully traverses these rejections.

Yamamoto does not disclose or suggest every aspect of the claimed invention. For example, each of independent claims 1, 22, 61, and 86 recites a device including, among other aspects, "wherein the end effector includes only two jaw members operable to open and close." Yamamoto does not disclose at least these aspects of the claimed invention in combination with the other aspects of each of respective claims 1, 22, 61, and 86.

The Office Action first refers to Figs. 16-17 of Yamamoto for its alleged disclosure of various elements of the independent claims. The Office Action recognizes that the end effectors of that embodiment do not fit within the lumen of the alleged tube when in the closed configuration. Page 3 of the Office Action then asserts that elastic members 132-134 in Figs. 13 and 22 of Yamamoto correspond to the claimed end effector. The Office Action therefore proposes the substituting of elastic members 132-134 into the device of Figs. 16-17. Yamamoto, however, discloses the use of three elastic members 132-134 in Figs. 13 and 22, and not "only two jaw members" as set forth in the claimed invention. Moreover, one of ordinary skill in the art would not have been motivated to reduce the number of elastic members 132-134 from three to two, as to do so would make it significantly more difficult for elastic members 132-134 to grab an object, rendering the device of Yamamoto unsatisfactory for its intended purpose, In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), and impermissibly changing the principle of operation of Yamamoto, In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Specifically, elastic members 132-134 are flexible along substantially their entire lengths. If only two such members were placed around, for example, a round or curved object such as a lesion in the gastrointestinal tract, the two flexible members may slide off the lesion at some point during the procedure. Such a complication would be much less likely to occur with the three flexible members of Figs. 13 and 22 of Yamamoto.

Accordingly, for at least these reasons, Applicant respectfully requests withdrawal of the Section 103(a) rejection based on Yamamoto.

On pages 3-4 of the final Office Action, dependent claims 5, 6, 11-13, 27-29, 35-37, 65, 66, 71-73, 91-93, and 99-101 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of U.S. Patent No. 6,066,102 to Townsend et al. ("Townsend"). Applicant respectfully traverses this rejection. As set forth above, Yamamoto does not disclose or suggest the combination of elements in each of independent claims 1, 22, 61, and 86. Townsend does not remedy the deficiencies of Yamamoto. The rejection, for example, relies on Townsend for its alleged disclosure relating to features of handles and elongate members in dependent claims. Applicant therefore respectfully requests withdrawal of the Section 103(a) rejection based on Yamamoto and Townsend.

Applicant presents new claims 120-135. No combination of Yamamoto and Townsend discloses or suggests the subject matter set forth in new claims 120-135. For example, new claims 120-123 each recites, among other aspects, "wherein the ring is disposed in the tube in both the open configuration and the closed configuration." Pages 2 and 3 of the Office Action asserts that female screw 24 and "the tubular channel [of module body 7] which receives wire 137" of Yamamoto correspond to the ring and the tube, respectively, of claimed invention. Even assuming *arguendo* this is correct, as shown in Fig. 17 of Yamamoto, however, ring 24 is disposed in operation channel 20 of endoscope 2, in at least the open configuration, and not in "the tubular channel [of module body 7] which receives wire 137."

In another example, new claims 124-127 each recites, among other aspects, "wherein the distal assembly includes a spring configured to exert a force to open the end effector, wherein the ring is disposed distal to the spring." Page 3 of the Office

Action asserts that female screw 24 and “the proximal portion of each member 132-134” of Yamamoto correspond to the ring and the spring, respectively, of the claimed invention. Even assuming *arguendo* this is correct, female screw 24 is disposed proximal, not distal, to “the proximal portion of each member 132-134.”

In a further example, new claims 128-131 each recites, among other aspects, “wherein the distal assembly includes a coil spring configured to exert a force to open the end effector.” Yamamoto does not disclose a coil spring, as the only spring cited by the Office Action is “the proximal portion of each member 132-134” of Yamamoto, which is not a coil spring.

In yet another example, new claims 132-135 each recites, among other aspects, “wherein the spring is disposed entirely within the tube in both the open configuration and the closed configuration.” Assuming *arguendo* that “the proximal portion of each member 132-134” and “the tubular channel [of module body 7] which receives wire 137” of Yamamoto correspond to the spring and the tube, respectively, of claimed invention, Yamamoto does not disclose that “the proximal portion of each member 132-134” is disposed entirely within “the tubular channel [of module body 7] which receives wire 137” in both the open configuration and the closed configuration. Figs. 13 and 22 disclose that substantially all of elastic members 132-134 are disposed outside of “the tubular channel [of module body 7] which receives wire 137” when elastic members 132-134 are in the open configuration.

Applicant further submits that claims 2-13, 15-21, 23-39, 62-73, 75-85, 87-107, 109, 112, 115, 118, and 120-135 depend either directly or indirectly from one of independent claims 1, 22, 61, and 86, and are therefore allowable for at least the same

reasons that their respective independent claims are allowable. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited references and therefore each also are separately patentable.

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Michael W. Kim
Reg. No. 51,880